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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,355	11/03/2005	Maximilian Grassberger	PD/4-32803A	2105
67283 7590 04/04/2008 MONTGOMERY, MCCrackEN, WALKER & RHOADS, LLP 123 SOUTH BROAD STREET AVENUE OF THE ARTS PHILADELPHIA, PA 19109				
EXAMINER				
CHOI, FRANK I				
ART UNIT		PAPER NUMBER		
1616				
MAIL DATE		DELIVERY MODE		
04/04/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/550,355

**Applicant(s)**

GRASSBERGER ET AL.

**Examiner**

FRANK I. CHOI

**Art Unit**

1616

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/7/2008 has been entered.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for synergistic effect as it pertains to inhibition of T-cell proliferation, it does not reasonably provide enablement for a claim that reads on any synergistic effect. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

#### ***The nature of the invention:***

The invention is directed to a method of treatment of a dermatological disease or inflammatory bowel disease in a subject suffering from or at risk for such condition, comprising co-administering a synergistically effect amount of the combination of a macrolide T-cell immunomodulator or immunosuppressant and a calcitrol.

#### ***The state of the prior art and the predictability or lack thereof in the art:***

The prior art discloses that rapamycin and 1,25(OH)<sub>2</sub>D<sub>3</sub> act synergistically as a immunosuppressive agent in the suppression of T-cell proliferation, however, the prior art does not provide evidence that the same when applied to a dermatological disease or inflammatory bowel disease would act synergistically with respect to treatment of the disease. The prior art does not provide evidence that other combinations of a macrolide and a calcitrol would act synergistically with respect to treatment of said diseases. As such, predictability in the art appears to be low as to whether a given combination would act synergistically with respect to a given dermatological disease or inflammatory bowel disease.

*The amount of direction or guidance present and the presence or absence of working examples:*

The Specification discloses a method for determining synergy, however, there is no evidence presented which shows what combinations or amounts if any acted synergistically with respect to treatment of the claimed diseases. See Ex Parte Quandranti, 25 USPQ2d 1071, 1072, 1073 (the facts shown must be analyzed to determine whether the method chosen to establish synergism clearly and convincingly demonstrates the existence of synergism, or more generally an unobvious result). Since no facts have been presented which establish that the compounds act synergistically with respect to the disease, the existence of synergism has not been clearly and convincingly demonstrated.

*The breadth of the claims and the quantity of experimentation needed:*

The claim is broad in that it claims any combination of a macrolide and a calcitrol and it potentially covers any person as there no minimum threshold as to which patients may be a risk for a given dermatological disease or inflammatory bowel disease. Further, the claims do not

indicate what the effect is in the synergistically effective amount, and, thus is open to any synergistic effect which might occur as a result of the combination of a macrolide and a calciferol, As such, one of ordinary skill in the art would be required to do due undue experimentation in order to determine what combinations and amounts would result in a synergistic effect, including whether the combination is synergistically effective with respect to treatment of the disease.

The Examiner notes that the fact that claim 3 has been rejected as being obvious does not enable the entire scope of the claim. The prior art rejection below is based on the interpretation of the claim as being open-ended with respect to the synergistic effect, whereas the synergistic effect in the prior art rejection below is directed to inhibition of T-cell proliferation. Since Applicant has not provide other evidence which supports the full scope the claim and “synergistically effective” encompasses any synergistic effect that might occur because of the combination, the prior art rejection below does not provide evidence which supports enable of the entire scope of the claim.

The Examiner had duly considered the Applicant's arguments but deems them unpersuasive. The Applicant argues that the one of ordinary skill in the art would be able to determine which amounts and combinations of amounts would provide a synergistic effect. The problem is that the Applicant does not indicate the synergistic effect. Further, The Applicant does not provide evidence in the form of affidavit or declaration as to other synergistic effects and as to whether any experimentation would not be undue. The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). “The reason for requiring evidence in declaration or affidavit form is to obtain

the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 25 and 18 U.S.C. 1001.” Permitting a publication to substitute for expert testimony would circumvent the guarantees built into the statute. *Ex parte Gray*, 10 USPQ2d 1922, 1928 (Bd. Pat. App. & Inter. 1989).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Etten et al. in view of WO 98/18468, Nghiem et al., Paul et al., Baumann et al. (US Pat. 5,912,238), Van De Kerkhof et al. and Koo et al. (US 2004/0202706).

Van Etten et al. disclose the combination of rapamycin or FK 506, which are T-cell immunosuppressants, and Vitamin 1,25(OH)<sub>2</sub>D<sub>3</sub> or the analogs of said vitamin, TX527, ZG 1423 and WU 515, in stock solutions diluted in peanut oil for in vivo use and in stock solutions in ethanol diluted in culture medium for in vitro use, which combinations acted synergistically to suppress T-cell proliferation (Pages 1932,1934,1936-1940). It is disclosed that due to its additional immunomodulating effects on other cell types of the immune system, said vitamin and especially its analogues are potent immunomodulatory drugs which can extend the therapeutic window of classical immunomodulators in the treatment of autoimmune diseases (Page 1940). A method of determining the synergistic effect of two drugs is disclosed (Page 1935). It is

disclosed that 1,25(OH)2D3 has undesired calcemic effects and that it is preferred to use analogues of 1,25(OH)2D3 which have relatively lower calcemic effects (Page 1938).

WO 98/18468 disclose that the combination of rapamycin and 1,25(OH)2D3 is useful in treating disease or disorders involving the immune system, including psoriasis, dermatitis, eczema and inflammatory bowel disease (Page 8, lines 25-36). It is disclosed that the combination can be formulated with a pharmaceutical carrier in amounts of 0.1-5%, preferably 2%, of active compound in topical vehicles (Page 9, lines 15-36, page 10).

Nghiem et al. disclose that Tacrolimus (FK506) and Pimecrolimus (SDZ ASM 981) are structurally similar macrolide immunosuppressants and are both topically effective in treating atopic dermatitis and that ointments containing 0.2%, 0.6% and 1% of pimecrolimus and ointments containing 0.03% or 0.1% of tacrolimus have been tested (Pages 228, 229, 231-235, 240, note 26,27,28). The chemical structure of Tacrolimus and Pimecrolimus is disclosed (Page 229).

Paul et al. disclose that ascomycin derivatives, such as SDZ ASM 981, represent a novel class of anti-inflammatory macrolactams and that SDZ ASM 981 has been shown to be effective in the treatment of atopic dermatitis, contact dermatitis and psoriasis (See entire reference).

Baumann et al. disclose that FK506 and 33-epi-33-chloro-FR 520 (the Examiner notes that the structure of 33-epi-33-chloro-FR 520 corresponds the structure of pimecrolimus disclosed in Nghiem et al.) are effective in the treatment of autoimmune diseases and inflammatory and hyperproliferative skin diseases, including psoriasis, atopic dermatitis, contact dermatitis, and acne, in amounts of 1-3% for topical use in a pharmaceutically acceptable carrier (Column 11, lines 35-68, Column 29, lines 1-65, Column 30, line 24).

Van De Kerkhof et al. disclose that calcipotriol and tacalcitol have less hypercalcaemic activity than vitamin D3 and are now well-accepted and are becoming a mainstay of antipsoriatic treatment (Page 415). A study is disclosed in which a tacalcitol ointment (4 micrograms/g) was used to treat chronic plaque psoriasis in daily amounts of 5g or less, greater than 5g to 7g or greater than 7g to 13g /day in which was effective and did not clinically or statistically alter serum calcium (Pages 415-419). It is disclosed that a previous study comparing calcipotriol ointment (50 micrograms/day, twice daily) and tacalcitol ointment showed that both treatments were effective and safe and did not significantly effect calcium metabolism (Page 420).

Koo et al. disclose the use of dermatological agents, including a vitamin D derivatives, calcipotriol, pimecrolimus and tacrolimus, and combinations thereof (Paragraph 0034). It is disclosed that the topical formulations of a dermatological agent may be in kits with instructions for use (Paragraphs 0060-0065).

The prior art discloses the combination of a macrolide T-cell immuomodulator and a calciferol with a pharmaceutical carrier. The difference between the prior art and the claimed invention is that the prior art does not expressly disclose the combination of 33-epichloro-33-desoxyascomycin and calcipotriol or tacalcitol, a method of treatment of a dermatological disease or inflammatory bowel disease with a macrolide T-cell immuomodulator and a calciferol in synergistically effective amounts or a kit of parts separately containing the same in unit dosage forms with instructions for use. However, the prior art amply suggests the same as the prior art discloses the combination of rapamycin and 1,25(OH)2D3 is use for the treatment of psoriasis, dermatitis, eczema and inflammatory bowel disease, that rapamycin or FK506 combined with 1,25(OH)2D3 or analogues thereof are synergistically effective in suppressing T-



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cell proliferation, that FK506 and pimecrolimus are structurally similar macrolide immunosuppressants which are effective in the treatment of dermatological diseases, including psoriasis, that calcipotriol and tacalcitol do not cause undesired effects on calcium metabolism as opposed to 1,25(OH)2D3 and that dermatological agents, such as vitamin D derivatives, calcipotriol, pimecrolimus and tacrolimus, and combinations thereof, can be in the form kits. As such, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to modify the prior art as above with the expectation that due to similar structure and effect on dermatological disease, that pimecrolimus (also referred to as 33-epichloro-33-desoxyascomycin in the Specification at page 3) would be a suitable substitute for rapamycin or FK506 and act synergistically in the inhibition of T-cell proliferation in combination with 1,25(OH)2D3 and analogues thereof, that due to their similar structure with 1,25(OH)2D3, effect on psoriasis and no effect on calcium metabolism, that calcipotriol or tacalcitol would be a suitable and preferred substitute for 1,25(OH)2D3, that the combination of pimecrolimus and calcipotriol or tacalcitol would be effective in the treatment of dermatological diseases and inflammatory bowel disease similar to the combination of rapamycin and 1,25(OH)2D3, and that dermatological agents can be conveniently packaged into kits with instructions for use.

The Examiner has duly considered the Applicant's arguments but deems them unpersuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Supreme Court in *KSR International Co. v. Teleflex Inc.*, held the following:

(1) the obviousness analysis need not seek out precise teachings directed to the subject matter of the challenged claim and can take into account the inferences and creative steps that one of ordinary skill in the art would employ;

(2) the obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents;

(3) it is error to look only the problem the patentee was trying to solve-any need or problem known in the filed of endeavor at the time of invention and addressed by the prior art can provide a reason for combining the elements in the manner claimed;

(4) it is error to assume that one of ordinary skill in the art in attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem-common sense teaches that familiar items may have obvious uses beyond their primary purposes, and in many cases one of ordinary skill in the art will be able to fit the teachings of multiple patents together like pieces of a puzzle (one of ordinary skill in the art is not automaton);

(5) it is error to assume that a patent claim cannot be proved obvious merely by showing that the combination of elements was "obvious to try". *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396, 1397 (U.S. 2007).

The Applicant argues that the effective filing date of the present invention, 4/4/2003, is before the filing date of the Koo et al. reference. However, the effective filing date of the Koo et al. reference is 2/7/2003 via the provisional application.

As indicated above there is no requirement that Van Etten et al. disclose the use of pimecrolimus. Obviousness does not require absolute predictability. Also, Van Etten et al. does not teach away from the claimed invention. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

Notwithstanding the Applicant's arguments, Nghiem et al. does disclose that Tacrolimus (FK506) and Pimecrolimus (SDZ ASM 981) are structurally similar macrolide immunosuppressants and are used to treat the same conditions. As such, there is motivation to substitute the pimecrolimus.

Although WO 98/18468 discloses the use of rapamycin, Van Etten et al. suggests that tacrolimus can substituted for rapamycin and Nghiem et al. suggests that pimecrolimus can substituted for tacrolimus. As such, contrary to the Applicant's arguments, the prior art does suggest that pimecrolimus can substitute for rapamycin.

This is a rejection based on a combination of references, as such, there is no requirement that Van De Kerkhof et al. disclose combinations.

As indicated above, there is no requirement that there be motivation to combine or modify the references. In any case, there is amply reasoning to combine pimecrolimus with calcipitriol or tacalcitol. The prior art suggests the combination of pimecrolimus and calcipitriol or tacalcitol, notwithstanding the differences in chemical structure between pimecrolimus,

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rapamycin and FK506. The prior art discloses that pimecrolimus is a T-cell immunomodulator similar to rapamycin and FK506 and that rapamycin and FK506 can be combined with vitamin D derivatives and that pimecrolimus is effective in treating psoriasis. Both calcipotriol and tacalcitol are disclosed to be effective in treating psoriasis, as such, one ordinary skill in the art would expect that the combination of pimecrolimus and calcipotriol or tacalcitol would also be effective in treating psoriasis.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

### ***Conclusion***

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is 571-273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (571)272-0610. Examiner maintains a compressed schedule and may be reached Monday, Tuesday, Thursday, Friday, 6:00 am – 4:30 pm (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Johann R. Richter, can be reached at (571)272-0646. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frank Choi  
Patent Examiner  
Technology Center 1600  
April 4, 2008

/Johann R. Richter/

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Supervisory Patent Examiner, Art Unit 1616